

REMARKS

Claims 1-34 are pending in this application. Claims 7-17, 20, 21, 24, 25 and 29 are withdrawn from consideration. Claims 22, 23 and 30-34 are rejected under 35 USC 102(b) as being anticipated by Schaufelberger (2,522,965). Claims 2-4, 6, 18, 19 and 26-28 are rejected under 35 USC 102(b) as being anticipated by Stotz (1,710,718). Claims 26 and 30-32 are rejected under 35 USC 102(b) as being anticipated by Jennings (4,370,909). Claim 1 is allowed. Claim 5 is objected to as being dependent upon a rejected base claim.

MPEP §2131 provides that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. The identical invention must be shown in as complete detail as contained in the claim. The elements must be arranged as required by the claim. The following paragraphs describe at least some of the elements of the rejected claims that are not described in the respective cited prior art patent.

Turning first to the 35 USC 102(b) rejections considering Schaufelberger, the applicant notes that claim 22 includes the limitation of "a structure defining a tunnel through which a cutting device may pass." Schaufelberger shows a tunnel, however, the cutting device does not pass through the tunnel. The saw 10 of Schaufelberger passes entirely outside of the work-feeding fixture of Schaufelberger, thus teaching away from claim 22.

Claim 22 also includes the limitation of "the structure comprising at least two work piece-contacting surfaces for applying force to a work piece on each of two opposed sides of the cutting device." The fixture of Schaufelberger has a work engaging member 50 that contacts the work piece on only one side of the cutting device 10, thus further teaching away from claim 22.

Claim 22 also includes the limitation of "a handle attached to the structure and moveably fixable at any one of a plurality of positions along a width of the structure for positioning the handle relative to the tunnel." The handle 46 of Schaufelberger can rotate about its pivot 47; however, it is only fixable at a single position, i.e. the position shown in FIG. 1 of Schaufelberger. The claim 22 limitations requires a handle that can

be fixed at any of a plurality of positions relative to the tunnel, whereas the handle of Schaufelberger can be fixed at only one position relative to its tunnel.

Because Schaufelberger fails to described each and every element as set forth in claim 22, Schaufelberger does not support the rejection of independent claim 22 or its dependent claim 23 under 35 USC 102(b). Withdrawal of this rejection and allowance of claims 22 and 23 are respectfully requested.

Continuing with the 35 USC 102(b) rejections considering Schaufelberger, the applicant notes that independent claim 32 includes the limitation of "an inside leg and an outside leg each extending from the body to contact the work piece on opposed sides of a cut line created by the blade." Schaufelberger does not have two separate legs that contact the work piece on opposed sides. Because the fixture of Schaufelberger contacts the work piece on only one side of the cut line, Schaufelberger actually teaches away from claim 32. Thus, the Schaufelberger patent fails to support the rejection of independent claim 32 and its dependent claims 33 and 34 under 35 USC 102(b). Reconsideration and withdrawal of these rejections are respectfully requested.

Moving now to the rejections under 35 USC 102(b) considering Stotz, the applicant has amended independent claim 2 to include the limitations of objected-to claim 5, thus placing claim 2 into condition for allowance, with claim 5 being cancelled. Claims 3, 4 and 6 depend from claim 2 and are thus now allowable. Withdrawn claims 7-17 become eligible for consideration and allowance upon the allowance of independent claim 2. Thus, the reconsideration and allowance of claims 2-4 and 6-17 are respectfully requested.

Continuing with the rejections under 35 USC 102(b) considering Stotz, the applicant has amended claim 18 to include the limitations of "a structure comprising a flat surface for movement along a fence of a cutting machine parallel to a cut line defined by a cutting device, the structure further comprising a first leg and a second leg defining a tunnel through which the cutting device may pass." The shoe heel attaching jack of Stotz has no such flat surface structure, since it is not intended to be moved along a fence of a cutting machine, nor it is used to create a tunnel through which a cutting device is passed.

The applicant has also amended claim 18 to include the limitations of "the structure comprising at least two co-planar work piece-contacting surfaces for applying

force to a surface of a work piece on each of two opposed sides of the cutting device." The device of Stotz teaches away from claim 18 because its work piece contacting surfaces are not co-planar and they do not apply force to a surface of a work piece on each of two opposed sides of a cutting device.

Thus, the amendments to independent claim 18 have overcome the rejection under 35 USC 102(b) in view of Stotz, placing independent claim 18 and its dependent claim 19 in condition for allowance. Withdrawn claims 20 and 21 become eligible for consideration and allowance upon the allowance of independent claim 18. Thus, the reconsideration and allowance of claims 18-21 are respectfully requested.

The applicant has also amended claim 26 to include the limitations of "a structure defining a tunnel through which a cutting device may pass, the structure comprising at least two co-planar work piece-contacting surfaces for applying force to a top surface of a work piece on each of two opposed sides of the cutting device." The work-piece contacting surfaces of Stotz are not co-planar and they do not apply force to a top surface of a work piece on each of two opposed sides of a cutting device.

Claim 26 has also been amended to include the limitations of "each of the at least two work-piece-contacting surfaces comprising an elastomer non-slip material comprising a plurality of recesses." The specification has been amended herein to add reference numeral 77 in FIG. 2 and numeral 101 in FIG. 5 wherein such recesses are illustrated as grooves. A revised copy of each of these figures is attached herewith to add these respective numerals. These changes to the specification and drawings are not new matter since the recesses are shown in the originally filed figures although they were not numbered. The device of Stotz does not utilize an elastomer non-slip material surface.

Thus, the rejection of independent claim 26 and its dependent claim 27 under 35 USC 102(b) in view of Stotz has been overcome, and reconsideration and allowance of these claims is respectfully requested.

Moving now to the rejections under 35 USC 102(b) considering Jennings, the applicant has amended claim 26 to include the limitations of "each of the at least two work-piece-contacting surfaces comprising an elastomer non-slip material comprising a plurality of recesses." Jennings teaches away from these limitations by showing the work-piece contacting surfaces to lack any non-slip material. This is because Jennings

imparts its pushing force to the rear of the work piece via heel 30 rather than through friction force along the top surface of the work piece. Reconsideration and withdrawal of this rejection of claim 26 under 35 USC 102(b) is respectfully requested.

The applicant has amended claim 32 to add the limitation of "a means for adjusting a distance between the inside leg and the outside leg to vary a width of a tunnel formed there between." The relative positions of the two legs of Jennings cannot be adjusted. Thus, this amendment overcomes the rejection of independent claim 32 under 35 USC 102(b) as being anticipated by Jennings. Reconsideration and allowance of independent claim 32 and its dependent claims 33 and 34 are respectfully requested.

The applicant has demonstrated above that the rejections under 35 USC 102(b) have been overcome. The applicant now proactively provides comment on the issue of whether or not the Stotz patent 1,710,718 can properly be used in combination with one of the other cited prior art patents to support a rejection of any claim under 35 USC 103. The applicant argues that Stotz is not properly combinable with either the Jennings or the Schaufelberger patent, as follows.

MPEP 2143.01 provides that the mere fact that references can be combined does not render the combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The present invention, the Jennings patent and the Schaufelberger patent all describe woodworking devices. The Stotz patent describes a shoe repair device. Woodworking involves pushing a work piece past a stationary cutting device. Shoe repair involves working on a stationary work piece with tools other than cutting devices, such as the nailing tool 13 shown in Stotz. Thus, there is no intrinsic basis in the prior art or other extrinsic factor that would provide a logical reason for one of ordinary skill in the art of woodworking to look to the art of shoe repair for a teaching of how to push a work piece past a cutting device. Furthermore, references are not properly combinable if their intended function would be destroyed. If one were to clamp a piece of wood into the shoe heel attaching jack of Stotz, there would be no way to move the wood past a cutting device, since the device of Stotz is designed to be retained in a stationary base illustrated as numeral 1. The court in *In re Clinton*, 527 F.2d 1226, 188 USPQ 365 (CCPA 1976) looked at the references to determine whether "the references by

themselves ... suggest doing what appellants have done." (188 USPQ at 367) There is nothing in Stotz that suggests that it should be combined with the woodworking devices of Jennings or Schaufelberger. Accordingly, the applicant submits that while Stotz may properly be used as a reference under 35 USC 102, it is not properly combinable with the other cited prior art patents under 35 USC 103.

New claims 35-39 have been added. No additional fee is required because claims 5, 24, 25 and 28-31 have been cancelled.

Reconsideration of the amended application in view of the above Remarks and allowance of claims 1-4, 6-23, 26, 27 and 32-39 are respectfully requested.

Respectfully submitted,



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